

## **II. REMARKS**

### **Preliminary Remarks**

Upon entry of this Amendment, claims 9, 10, 26, and 27 will be pending, of which claim 27 is independent. Claim 1 and 2 are canceled by this Amendment, claims 3 to 8 and 11 to 25 were previously canceled. Claim 26 is withdrawn from consideration for being directed to a non-elected invention and claim 27 is new. Support for the new claim can be found in the specification and claims as originally filed (see, for example, claim 1). Therefore, the applicants believe that no new matter is added.

Claims 1 and 2 were objected to for being drawn, in part, to a non-elected invention. These claims are canceled and the applicants respectfully request withdrawal of this objection.

This response is filed within the shortened statutory period for response, with no fee due. The applicants respectfully request reconsideration and allowance of the present application.

### **Patentability Remarks**

#### ***Rejection under 35 U.S.C. §112 –***

Claims 1 and 2 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. These claims are canceled rendering this rejection moot and the applicants respectfully request its withdrawal.

#### ***Rejections under 35 U.S.C. §103 –***

Claim 9 was rejected under 35 U.S.C. §103(a) as unpatentable over Del Soldato *et al.* (WO 95/30641). The applicants respectfully traverse in view of the preceding claim amendments and succeeding remarks.

According to the examiner, Del Soldato *et al.* disclose the genus of compounds as anti-inflammatory agents within which the currently claimed compound is a species. The examiner admits that while Del Soldato *et al.* do not specifically disclose the claimed species, it would have been obvious to prepare the specific compound of the presently claimed invention because it is within the scope of the genus disclosed by Del

Soldato *et al.* and there is motivation to prepare the species presently claimed because of an expectation of success in preparing an agent suitable for anti-inflammatory treatments.

The applicants respectfully submit that the examiner has improperly applied hindsight reasoning to conclude that it would have been obvious to prepare the specific compound of the presently claimed invention. Under M.P.E.P. §2141.01 the teachings of Del Soldato *et al.* must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. In particular, there is simply no teaching or suggestion in Del Soldato *et al.* that would lead one to select the compound of claim 9. One skilled in the art at the time of the invention would not have known how to select the presently claimed compound from the myriad possibilities within the genus disclosed by Del Soldato *et al.* This information was not within the level of ordinary skill in the art at the time the claimed invention was made.

Therefore, the applicants respectfully submit that claim 9 is not unpatentable over Del Soldato *et al.* and request withdrawal of this rejection.

Claims 1, 2, and 10 were rejected under 35 U.S.C. §103(a) as unpatentable over Del Soldato *et al.* in view of Armour *et al.* (U.S. Pat. No. 5,703,240). The applicants respectfully traverse in view of the preceding claim amendments and succeeding remarks.

Claims 1 and 2 are canceled. With respect to claim 10, and newly added claim 27, the applicants respectfully submit that the examiner has, once again, improperly used hindsight reasoning. Del Soldato *et al.* provide no guidance for selecting the sub-genus of the presently claimed invention from among several disclosed genres. Similarly, Armour *et al.* provide no guidance for selecting urinary incontinence from a laundry list of possible inflammatory diseases. In contrast to the examiner's apparent assertion, there is no reasonable basis for expecting that every anti-inflammatory agent can be used to treat every inflammatory condition (much less urinary incontinence).

In conclusion, the applicants respectfully submit that it would not have been obvious to one skilled in the art at the time of the invention to treat urinary incontinence with the compound of claim 9 or the compounds of newly added claim 27. Therefore,

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**Inventor(s):** Del Soldato *et al.*  
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the applicants respectfully submit that claim 10 (and newly added claim 27) is/are not unpatentable over Del Soldato *et al.* in view of Armour *et al.* and request withdrawal of this rejection.


### III. CONCLUSION

In view of the amendments and remarks above, the applicants respectfully submit that this application is in condition for allowance and request favorable action thereon.

In the event this response is not timely filed, the applicants hereby petition for an appropriate extension of time. The fee for this petition, along with any additional fees required with respect to this response, may be charged to Deposit Account No. 01-2300, referencing Attorney Docket No. 026220-00031.

Respectfully submitted,

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